

NE. geographical position of the mobile cell phone either via determination of the radio cell positioned in the phone or via GPS, and is compared with a list of allowed locations. In this method, however, the client has to feed in all information via cell phone which may be arduous and temperamental for errors in view of the mostly small keys and small displays on the one hand, and on the other hand requires a comparatively long mobile cell connection.--

### REMARKS

Reconsideration of this application in view of the above amendments and the following remarks is requested.

Claims 6, 8 and 20 have been cancelled. New claims 23-33 have been added. Claims 1, 5, 7, 9-17, 21 and 22 have been amended, and the other pending claims have been maintained in their existing form. Claims 1-5, 7, 9-19, and 21-33 are pending.

A marked-up version of the amended claims is attached pursuant to 37 CFR § 1.121.

### Objections under 35 CFR § 1.75(c)

Applicant has made an earnest attempt to address the objections under 37 CFR § 1.75(c).

### Rejections under 35 U.S.C. § 112, second paragraph

Applicant has made an earnest attempt to address the rejections under 35 U.S.C. § 112, second paragraph.

### Rejections under 35 U.S.C. § 103

Claims 1 and 3 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hultgren (WO 98/47116) in view of Musa (U.S. Patent No. 6,016,349).

Applicant respectfully disagrees with the rejections of claims 1 and 3 under 35 U.S.C. § 103(a), because the applied references are defective in establishing a prima facie case of obviousness. As stated in MPEP § 2142, "...The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima

facie case, the applicant is under no obligation to submit evidence of nonobviousness..." In view of the following mutually exclusive reasons, and for other reasons clearly apparent, Applicant respectfully submits that a prima facie case of obviousness is not factually supported in this case.

**1. Even if cited aspects of the applied references are combined as proposed in the Office Action, they fail to teach the claimed subject matter**

Hultgren in view of Musa cannot be applied to reject claims 1 and 3 under 35 U.S.C. § 103, which states: "A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains ..." (Emphasis added). Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.

Musa discloses a cell phone which uses a smart card 5 (see Fig. 1).

Hultgren discloses a method for effecting of payments by a client to a merchant via telecommunication device as well as a corresponding device for effecting the method. In Hultgren, the client starts the payment by first transmitting at least a merchant's code and the amount to be paid via a cell phone to a so-called telepay device which can build up connections to the client's bank, to the merchant's bank and to the merchant himself. This transaction data is intermediately stored by the telepay device and sends requests for confirmation to the client and/or after building up of a corresponding communication connection and transmitting of a transaction code being specific for this transaction and of the amount to be confirmed - to the merchant. After the confirmation was received, the amount is transferred by a bank specified by a merchant's entry in a data base of the telepay device, respectively, the first bank is requested to transfer. Hereby is preferably determined for safety reasons the geographical position of the mobile cell phone either via determination of the radio cell positioned in the phone or via GPS, and is compared with a list of allowed locations. In Hultgren, however, the client has to feed in all information via cell phone which may be arduous and temperamental for errors in view of the mostly small keys and small displays on the one hand, and on the other hand requires a comparatively long mobile cell connection.

According to claim 1 of Hultgren, only a confirmation by the merchant is necessary.

Hultgren requires the client to feed (via mobile cell phone) all data for an electronic payment transaction. Hultgren has the following disadvantages: lacks a security against the own incorrect fed data; the mobile cell phone connecting time is long in view of the feeding of the data by the client and as they have to be kept available until the confirmation information (on the amount) is given by the merchant.

In the introduction to the specification of Hultgren, the method requires a confirmation by the merchant and by the client. The client feeds all the data, the merchant confirms the amount fed, and the client is asked to confirm this feeding. The number of steps is comparatively high, and the client only additionally verifies his own fed data. There is no independent system to receive the client's authorization.

No cited aspect of Hultgren or Musa teaches the recited combination of elements in claim 1, including:

- (a) start of method at the merchant, and start of confirmation by the client;
- (b) start of method contemporary after feeding in the amount and the merchant's code to the comparing device; and
- (c) confirmation call by the client with transmitting of SIM-card's code of the client's mobile cell phone to the comparing device.

Moreover, no cited aspect of Hultgren or Musa teaches the recited combination of elements in claim 3, including:

- (a) start of method with the merchant (not with the client);
- (b) start of method contemporary by notification of the SIM-card's code of the client's mobile cell phone to the merchant;
- (c) directly performed phone call at the client from the merchant via comparing device; and
- (d) authorization of the payment by the client only as confirmation via an independent route.

Accordingly, it is impossible for the cited aspects of Hultgren or Musa to render obvious the subject matter of claim 1 as a whole or claim 3 as a whole, and the explicit provisions of 35 U.S.C. § 103 are not met.

Thus, for this mutually exclusive reason, the PTO's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejections of claims 1 and 3

under 35 U.S.C. § 103 should be withdrawn.

## **2. The combination of references is improper**

MPEP § 2142 states: "...the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made...The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed "as a whole."

Moreover, MPEP § 2143.01 states: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."

In this case, the cited aspects of the applied references fail to teach, or even suggest, the desirability of the claimed combinations. Accordingly, they clearly fail to provide any incentive or motivation supporting the desirability of the claimed combinations. Combination of the applied references would arise solely from hindsight based on Applicant's teachings. Consequently, the applied references fail to provide any basis for combining in a 35 U.S.C. § 103 rejection.

Thus, for this mutually exclusive reason, the PTO's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejections of claims 1 and 3 under 35 U.S.C. § 103 should be withdrawn.

## **CONCLUSION**

In view of the foregoing amendments and remarks, and for other reasons clearly apparent, independent claims 1 and 3 are in condition for allowance.

Dependent claims 2, 9-18, 21 and 22 depend from and further limit independent claim 1 and therefore are allowable.

Dependent claims 4, 5, 7, 19 and 23-33 depend from and further limit independent claim 3 and therefore are allowable.

An early formal notice of allowance of claims 1-5, 7, 9-19, and 21-33 is requested.

Other than an extension of time fee, no additional fee is believed due. Nevertheless, to the extent that the present amendment results in additional fees, the Commissioner is authorized

to charge deposit account no. 08-1394.

If any unresolved aspect remains, the Examiner is invited to call the telephone number listed below.

Respectfully submitted,



Michael A. Davis, Jr.

Registration No. 35,488

Signed under 37 CFR § 1.34(a)

Date: 2/04/2002

HAYNES AND BOONE, LLP

901 Main Street, Suite 3100

Dallas, Texas 75202-3789

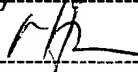
Telephone: (214) 651-5634

Facsimile: (214) 651-5940

Docket No. 12964.15

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231

on 2/4/2002



**AMENDED CLAIMS**

1. A method of effecting a cashless payment transaction by means of a merchant station (1) characterized by a merchant station identification code, a mobile cell phone (2) with a SIM card characterized by an identification code identifying the SIM card [it], and a comparing device (3), which comprises a transaction data memory device (10), a merchant checking device (11) for checking the identification codes of the merchant stations authorised for this method, and a subscriber checking device (12) for checking the identification codes of the SIM cards authorised for this method and which is connected to account keeping devices (15), comprising the steps:
  - reading an amount of money to be paid into the merchant station,
  - transmitting the identification code of the merchant station and at least the amount of money to the comparing device with this identification code through a data link,
  - checking the authority of the merchant station for the method, using the merchant checking device,
  - terminating the method in the absence of the authority, otherwise writing the data as an open transaction into the transaction memory device of the comparing device,
  - making a connection from the mobile cell phone to the comparing device,
  - transmitting the identification code of the merchant station and the identification code associated with the SIM card from the mobile cell phone to the comparing device,
  - checking the authority of the SIM card for the method, using the subscriber checking device, in the absence of the authority terminating the method, clearing the open transaction from the transaction memory and transmitting corresponding data to the merchant station, otherwise comparing the merchant station identification code transmitted from the mobile cell phone with those of the open transactions stored in the transaction memory device and on failure to find such a transaction terminating the process and, on finding the process,
  - transmitting the transaction data to the mobile cell phone,
  - outputting the data through the mobile cell phone,
  - requesting confirmation information through the mobile cell phone,
  - transmitting the confirmation data to the comparing device,
  - terminating the transaction and clearing the transaction from the transaction memory if

31 the confirmation data corresponds to a refusal, and transmitting the transaction data from  
32 the transaction memory and the identification code of the mobile cell phone to an account  
33 keeping device and clearing the transaction from the transaction memory in the  
34 alternative case.

1 5. A method according to claim 3 [any of the preceding claims], characterized in that the  
2 transaction is broken off if confirmation information is not given within a predetermined  
3 time after transmitting the information from the merchant station to the comparing  
4 device.

1 7. A method according to claim 3 [claim 6], characterized in that as well as the merchant  
2 identification code, further data on the transaction is read [transmitted] in the first step.

1 9. A method according to claim 2 [any of the preceding claims], characterized in that at  
2 least one of the wireless interfaces [interface] is an infrared interface.

1 10. A method according to claim 2 [any of the preceding claims], characterized in that at  
2 least one of the wireless interfaces [interface] is a microwave interface.

1 11. A method according to claim 1 [any of the preceding claims], characterized in that further  
2 supplementary transaction data is transmitted to the comparing device or mobile cell  
3 phone from the merchant station.

1 12. A method according to claim 1 [any of the preceding claims], characterized in that when  
2 one of the necessary connections cannot be made, the transaction is terminated and if  
3 required the corresponding, stored open transactions in the transaction memory (19) of  
4 the comparing device (3) are cleared.

1 13. A method according to claim 1 [any of the preceding claims], characterized in that the  
2 identification codes are replaced by the corresponding data identifying the account before  
3 transmission to the account keeping devices (15).

- 1 14. A method according to claim 1 [any of the preceding claims], characterized in that, when  
2 no connection can be made to the merchant station (1) or the mobile cell phone 2, at least  
3 one further attempt is made to make this connection and the process is only then  
4 terminated.
- 1 15. A method according to claim 1 [any of the preceding claims], characterized in that when  
2 one of the connections cannot be made, a communication is given to the merchant station  
3 (1) or the mobile cell phone (1), before the procedure is terminated.
- 1 16. A method according to claim 1 [any of the preceding claims], characterized in that the  
2 identification code associated with the SIM card is an identification code stored on the  
3 SIM card and identifying the card and the transmission of the identification code  
4 associated with the SIM card takes place automatically in the transmission of data  
5 between the mobile cell phone (2) and the comparing device (3).
- 1 17. A method according to claim 1 [any of the preceding claims], characterized in that the  
2 identification code associated with the SIM card is its telephone number.
- 1 21. A system according to claim 18 [any of claims 18 to 20], characterized in that the  
2 comparing device (3) comprises a subscriber checking device (12) in which is held the  
3 identification code of each mobile cell phone and the account number associated  
4 therewith in the account keeping device, and in that the control device transmits to the  
5 account keeping device the account number corresponding to the identification code, on  
6 the basis of the information in the subscriber checking device, rather than the  
7 identification code of the mobile cell phone.
- 1 22. A system according to claim 18 [any of claims 18 to 20], characterized in that the  
2 comparing device (3) comprises a merchant checking device (11) in which is held the  
3 identification code of each merchant station and the account number associated therewith  
4 in the account keeping device, and in that the control device transmits to the account  
5 keeping device the account number corresponding to the identification code, on the basis



6 of the information in the merchant memory device, rather than the identification code of  
7 the merchant station.